

REMARKS

I. PENDING CLAIMS AND SUPPORT FOR AMENDMENTS

Upon entry of this amendment, claims 3-5, 10-20, 23-28 and 31-43 are pending in this application. Claims 29-30 have been cancelled with this amendment.

Claims 5 and 31 have been amended to incorporate all of the limitations of the respective base claims and any intervening claims and are therefore allowable as indicated by the Examiner on page 5 of the Action.¹

Claims 3-4, 12, 15, 18-19, 24-28, 32-37 and 40-42 have been amended either to correct dependency, antecedent basis, typographical error, or other similar issue.

Claim 23 has been amended to include all of the limitations of claims 15 and 24-26.

No new matter has been added.

II. THE CLAIMS ARE PATENTABLE UNDER 35 U.S.C. § 112

On page 2 of the Office Action, the Examiner rejected claims 15-18 and 40-41 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because claim 23 recites “a collet” and claim 15, which depends from claim 23, recites “a collet having a proximal end.” Claim 15 now depends from independent claim 5 and claim 15 has been

¹ Claim 31 does not include language requiring that the blade bar have a portion for urging the distal end of the blade into engagement with the handle body, as this language was the basis of a rejection under 35 U.S.C. § 112.

amended to remove reference to the collet. Claim 40 now depends from independent claim 31 and claim 40 has been amended to remove reference to the collet. Thus, withdrawal of this rejection is respectfully requested.

Examiner rejected claims 29-43 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because claim 29 recites that the blade bar has a portion for “urging the distal end of the blade into engagement with the handle body.” Independent claim 29 has been cancelled, and claim 31 does not include the objected to language. Withdrawal of this rejection is respectfully requested.

III. THE CLAIMS ARE PATENTABLE UNDER 35 U.S.C. § 102

On page 3 of the Office Action, the Examiner rejected claims 3, 4, 10-14, 19, 23-30 and 32-39 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,779,724 to Werner (“*Werner*”). Claims 3, 4, 10-14, 19 and 24-28 now depend from newly amended independent claim 5 or from an intervening claim. Claims 32-39 now depend from newly amended claim 31 or from an intervening claim. Claims 5 and 31² have amended to incorporate all of the limitations of the respective base claims and are now in condition for allowance, as indicated by the Examiner on page 5 of the Action. Thus, all of dependent

² As noted above, claim 31 does not include language requiring that the blade bar have a portion for urging the distal end of the blade into engagement with the handle body, as this language was the basis of a rejection under 35 U.S.C. § 112.

claims 3, 4, 10-14, 19, 24-28, and 32-39 are allowable as well. Claims 29-30 have been cancelled.

Independent claim 23 has been amended to include the limitations of claim 15, which is not rejected under 35 U.S.C. § 102(e) as being anticipated by *Werner*, and the limitations of claims 24-26. Thus, the undersigned respectfully traverses this rejection and requests that it be withdrawn.

IV. REJECTIONS BASED ON 35 U.S.C. § 103

The March 10, 2009 Office Action rejected claims 15-18, 20, 40-41 and 43 under 35 U.S.C. § 103(a) as being unpatentable over *Werner* in view of U.S. Pat. No. 5,867,912 to Hickok et al. ("hereinafter "*Hickok*"). Claims 26-27 and 33-34 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Werner* in view of U.S. Patent No. 5,984,918 to Gartito et al. (hereinafter "*Gartito*"). As noted above, claims 15-18 and 20 now depend from allowable claim 5. Claims 40, 41 and 43 now depend from allowable claim 31. The outstanding rejection of claim 23, which has been amended to include the limitations of claims 15 and 24-26, is addressed below.

M.P.E.P. 2141 explains what is required where an obviousness rejection is made:

As reiterated by the Supreme Court in *KSR*, the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated

in *Graham v. John Deer Co.* Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the difference between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.

Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. . . .

Office personnel fulfill the critical role of fact finder when resolving the *Graham* inquiries. . . . Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied. . . .

Once the findings of fact are articulated, Office personnel must provide an explanation to support an obviousness rejection under 35 U.S.C 103.

The March 10, 2009 Office Action does not comply with these requirements. For the reasons explained in detail below and with specific reference to the Examiner's rejections, neither *Werner* nor *Hickok et al.* nor any other relevant prior art of record, singly or in combination, discloses each and every element of amended claim 23.

Amended claim 23 requires a handle assembly for a detachable scalpel blade having a keyed slot, the handle assembly comprising a handle body having a longitudinal axis and a handle grip, protruding from the handle body a blade bar having a tang for insertion in the keyed slot, a spring for urging the distal end of the blade bar into the handle body, and a

collet with a proximal end having a bore through, and a collet core comprising a slit and at least one face of the collet core sloping toward the slit.

The Examiner has failed to present a *prima facie* case of obviousness at least because the references do not teach or suggest all of the limitations of claim 23. Neither *Werner* alone, nor *Werner* in combination with *Hickok et al.* or *Gartito* or any other reference discloses every limitation of amended claim 23.

First, *Werner* fails to disclose a collet core, as acknowledged by the Examiner in this action. Nor does *Werner* disclose a collet core having a slit, as required by amended claim 23. On page 3 of the action, the Examiner asserts that element 106 of *Werner* satisfies the limitation of “a slot.” However, element 106 is the through bore of the device described in *Werner*. See *Werner*, col. 9, ll. 7. In contrast, the claimed element is a narrow slit, as illustrated in Figure 13 of the pending application, reproduced below. Thus, the bore 106 of *Werner* is not a slit as described and claimed in this application. *Werner* therefore fails to disclose a collet and a collet core having a slit, with at least one face of the collet core sloping toward the slit, as required by amended claim 23. Further, neither *Hickok et al.* nor *Gartito* disclose a collet core having a slit with at least one face of the collet core sloping toward the slit, as required by amended claim 23.

CONCLUSION

The foregoing is submitted as a full and complete response to the Office Action. Assignee submits that the claims are allowable for at least the reasons set forth above, and allowance of the claims is respectfully requested.

Please charge any additional fees or credit any overpayment to Deposit Order Account No. 11-0855.

Respectfully submitted,

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